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The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 19

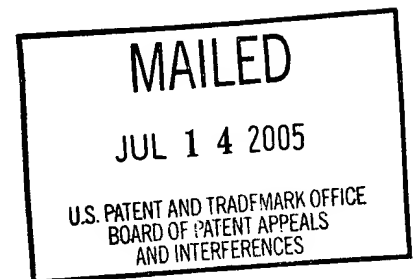
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL I. KERPELMAN, RICHARD L. FROWEIN,
HUBERT ANTHONY ZETTEL, JAMES F. KOHLI, and
JOHN HEINEN

Appeal No. 2005-0061
Application No. 09/470,554

ON BRIEF



Before DIXON, GROSS, and BARRY, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-32, which are all of the claims pending in this application.

We REVERSE.

Appellants' invention relates to an integrated interactive service to a plurality of medical diagnostic systems. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method for providing service data to medical diagnostic systems, the method comprising the steps of:
 - (a) generating a diagnostic system service request for a designated diagnostic system coupled to an internal network of a medical diagnostic facility;
 - (b) transmitting the request to a remote service provider over an external network via a data communication control system coupled to a plurality of diagnostic systems over the internal network;
 - (c) receiving and processing the request at the remote service provider;
 - (d) transmitting a response from the remote service provider in response to the request.

The prior art of record relied upon by the examiner in rejecting the appealed claims is as follows:

Ballantyne et al. (Ballantyne)	5,867,821	Feb. 2, 1999
Wong et al. (Wong)	6,260,021	Jul. 10, 2001 (filed Jun. 12, 1998)

Claims 1-13 and 15-32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wong in view of Ballantyne. Claim 14 stands rejected under 35 U.S.C. § 103 as being unpatentable over Wong and Ballantyne in view of Official Notice.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 13, mailed Dec. 3, 2003) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 12, filed Sep. 2, 2003) and reply brief (Paper No. 14, filed Feb 9, 2004) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d

1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in art would lead that individual to combine the relevant teachings of the references.'" **In re Lee**,

277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations set forth in independent claim 1. Claim 1 requires "generating a diagnostic system service request for a designated diagnostic system" and "transmitting the request to a remote service provider." The examiner maintains that the teachings of Wong with respect to medical image distribution to client workstations from the Picture Archival Communication and Radiology system over the Internet/intranet teach the claimed "generating a diagnostic system service request for a designated diagnostic system" and "transmitting the request to a remote service provider." (Answer at pages 3-4.) The examiner maintains that Wong fails to explicitly teach the portions of the claimed communication control system, processing the request at a remote service

provider and transmitting a response to the request. (Answer at page 5.) The examiner relies on the teachings of Ballantyne for distributing and administering medical services and electronic medical records. (Answer at page 5.) While we agree with the examiner that both Wong and Ballantyne are directed to distributing and administering medical related data, we find that neither reference teaches or fairly suggests the claimed "generating a diagnostic system service request for a designated diagnostic system" and a response thereto.

Appellants argue that "data communications control system," "diagnostic system," and "service request" are described and defined throughout the present application. (Brief at page 6 and reply brief at page 3.) The examiner controverts appellants' assertion that these terms are specifically defined and that they should be given their ordinary and customary meaning and that the teachings of Wong and Ballantyne teach the limitations as interpreted in view of the "non-committal" terms used in the specification. (Answer at pages 18-22.) While we agree with the examiner that the specification does not specifically define these terms, their interpretation must be in the context of the claim as a whole rather than taken individually in a piecemeal fashion.

The preamble of independent claim 1 sets forth a "method for providing service data to medical diagnostic systems" and the remainder of the claim accomplishes this recited method. Here, we find that the examiner's interpretation of these terms is not

reasonable. Here, the service is provided to a diagnostic system, but the teachings of Wong and Ballantyne are directed to providing information and services to the end user rather than to the diagnostic systems. Therefore, we find that the examiner's interpretation of the claim terms/language is not reasonable when interpreting the claim as a whole. We find that in the examiner's interpretation of the claimed invention, the "request" is in the wrong direction with respect to the diagnostic systems. Therefore, we cannot sustain the rejection of independent claim 1 and its dependent claims 2-13 and 15. Nor do we find that the examiner's reliance upon Official Notice remedies the deficiency in the combination of Wong and Ballantyne. We find similar limitations in independent claims 16 and 25 and their dependent claims, and we cannot sustain the rejection of independent claims 16 and 25 and their dependent claims 17-24 and 26-32.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 1-32 under 35 U.S.C. § 103 is reversed.

REVERSED


JOSEPH L. DIXON
Administrative Patent Judge

Anita Pellman Gross
ANITA PELLMAN GROSS
Administrative Patent Judge


LANCE LEONARD BARRY
Administrative Patent Judge

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